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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,889	12/27/2000	Florian M. Kehlstadt	5509	2729

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EXAMINER

HAILU, TADESSE

ART UNIT	PAPER NUMBER
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2173

4

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary

Application N .

09/750,889

Examiner

Tadesse Hailu

Applicant(s)

KEHLSTADT ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 is/are allowed.
- 6) ☒ Claim(s) 1-8, 16, 18-29 is/are rejected.
- 7) ☒ Claim(s) 9-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

DETAILED ACTION

1. This Office Action is in response to the patent application (09/750,889) filed on 12/27/2000.
2. The present patent application is a CIP of application 09/571,006 (5/15/2000) and claims priority from this application.

Information Disclosure Statement

3. The submitted Information Disclosure Statement with reference is considered and entered.

Status of the claims

4. Claims 1-29 are examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 18-27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8, 19, 20, 26, 27 recite the limitations "the texture", and "the control device" in the second line of each respective claims. There are insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-8, 16, 26 and 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Jeffway, Jr. et al (6,422,942).

Jeffway discloses a tracking device that is designed for implementing a virtual game board and its game functions. The game unit 20 is in essence an improved cursor-positioning device that is commonly to as a "mouse" for use with personal computers. The device may be structured to create sound and physical effects associated with certain events in a game (column 2, lines 18-26).

With regard to claim 1:

Jeffway describes notifying a game player (computer user) of occurrence of an event.

Jeffway further describes a user playing (communicating) a game on the personal computer.

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Jeffway also describes an event signal indicating an occurrence of an event (column 5, lines 22-38); Jeffway further describes a tracking device (mouse) to notify the player of the game that the event has occurred (column 5, lines 22-38).

With regard to claim 2:

Jeffway further describes providing the user with a visual indication on the tracking device (mouse) that the event has occurred (column 5, lines 22-38, column 6, lines 27-40).

With regard to claim 3:

Jeffway further describes LED for illumination on the control device (column 6, lines 27-40).

With regard to claim 4:

Jeffway further describes LED that blinks when an event occurred (column 6, lines 27-40).

With regard to claim 5:

Jeffway further describes providing the user with an audio indication on the control device that the event has occurred (column 5, lines 22-38).

With regard to claim 6:

Jeffway further describes providing the user with a vibratory indication on the control device that the event has occurred (column 5, lines 22-38).

With regard to claim 7:

Jeffway further describes providing the user with a tactile indication on the control device that the event has occurred (column 5, lines 22-38).

With regard to claim 8:

Jeffway describes notifying a game player (computer user) of occurrence of an event. Jeffway describes a user playing (communicating) a game on the personal computer. The tracking device (mouse) includes a physical effect (Fig. 7, #52), the change in the physical effect notifies the player of the game. Visual indication of game play may be provided by a set of LEDs 52 positioned on the top of the housing 54. The LED corresponding to the direction of movement may be lit to visually alert the player of what lies ahead (column 6, lines 26-40).

With regard to claim 16:

Jeffway describes that the tracking device is also a mouse (Fig. 9).

With regard to claim 26:

In addition to reasons of rejection to claim 8, Jeffway further describes that the physical restraints and effects may be provided by solenoid or piezo driven actuators acting on the ball 24 and vibration generators acting on the housing. (Column 5, lines 22-37).

With regard to claim 27:

This independent claim, while not necessary identical in scope with claim 26, contain limitations similar to independent claim 26 and therefore are rejected under the same rationale.

With regard to claim 28:

Independent claim 28 corresponds generally to independent claim 1 and recites similar features in a computer program product form, and therefore is rejected under the same rationale.

With regard to claim 29:

Independent claim 29 corresponds generally to independent claim 8 and recites similar features in a computer program product form, and therefore is rejected under the same rationale.

Allowable Subject Matter

7. Claims 17-25 are allowed.

The following is an examiner's statement of reasons for allowance .

While Jeffway discloses a plurality of pegs (fig. 8, #68), but these pegs are not for changing the physical effect or texture of the control device. Thus, Jeffway fails to describe the physical effect (altering the texture) to include "raising a plurality of pegs through a plurality of apertures in the region on the mouse" (claim 17); Jeffway also fails to describe the followings: "a plurality of pegs in the region on the control device for changing the texture of the control device" (claim 18); "a key plate comprising a plurality of pegs , a portion of which can protrude through the key plate to change the texture of the region on the control device." (claim 19); a pegs plate comprising a plurality of pegs, a portion of which can protrude through the key plate to change the texture of the region on the device" (claims 20-25).

Thus, prior art neither renders obvious nor anticipates the combination of claimed elements in light of the specification.

8. Claims 9-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: while Jeffway discloses a plurality of pegs (fig. 8, #68), but these pegs are not for changing the physical effect or texture of the control device. Jeffway further fails to describe the physical

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effect (altering the texture) to include "raising a plurality of pegs through a plurality of apertures in a surface of the control device." (claims 9) Jeffway also fails to disclose that the actuator module as being bi-stable (claim 12); a flexible (push) lever (claim 10); a plurality of pegs in a grid shape (claim 14); a plurality of pegs in quincunx configuration (claim 15).

Thus, prior art neither renders obvious nor anticipates the combination of claimed elements in light of the specification.

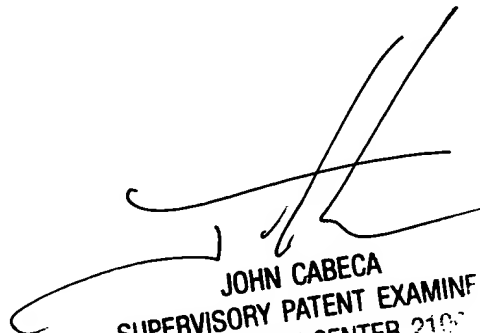
Conclusion

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (703) 306-2799. The Examiner can normally be reached on M-F from 10:00 - 8:30 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (703) 308-3116 Art Unit 2173 CPK 2-4A51.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu

April 27, 2003


JOHN CABECA
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